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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,690	11/10/2000	Chris Carmichael	SD-CARM1-SCH051006-1-SXG	5681
74162 7590 12/04/2007 Law Office of Scott C Harris PO Box 1389 Rancho Santa Fe, CA 92067			EXAMINER O'CONNOR, GERALD J	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 12/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/710,690

Applicant(s)

Carmichael et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 30, 2006 (Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 10, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Preliminary Remarks

1. PLEASE TAKE NOTICE that the examiner handling this application has changed. The new examiner is *Jerry O'Connor*. The Group Art Unit number is unchanged and is still 3627.
2. This Office action responds to the amendment and arguments filed by applicant on October 30, 2006 in reply to the previous Office action on the merits, mailed May 23, 2002.
3. The amendment of claims 5, 9, and 18 by applicant in the reply filed October 30, 2006 is hereby acknowledged.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Garg (US 6,009,407).

Garg discloses a method of providing sales statistics comprising the steps of receiving shipment information and sales information; maintaining the shipment information; and analyzing the information to determine statistics on sales, wherein such statistics are used to generate future orders (col. 10, lines 1-33). These statistics are provided to the retailer, since the retailer generates them. Sales statistics are also provided to the manufacturer, since the order is a function of the sales statistics. Garg does not disclose the use of a database to store the shipment and sales information. However, Garg states that the inventory data is updated (col. 10, lines 10-15). In order to update data, it is inherent that the data must have been stored in an area. Webster's dictionary defines a database as "a usually large collection of data organized especially for rapid search and retrieval (as by a computer)". Therefore, the area in which the data is stored is a database by definition. It is therefore inherent that Garg must employ a database for the sales and shipment information, and that the database would be used and controlled by the managers, thus would be remote from the manufacturers and retailers.

Regarding claim 20, since the replenishment order generation system generates orders for a specific store, it is inherent that the actual sales are categorized by store. Since each store is located in a geographic territory, the actual sales are thereby categorized by geographic territories.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garg (US 6,009,407).

Garg discloses a method of providing sales statistics, as applied above in the rejection of claim 18 under 35 U.S.C. 102(e), and Garg also discloses all of the limitations of claim 19, except for a teaching of providing the statistics to manufacturers or retailers requesting the statistics. However, it is common in the art to provide sales statistics to a requesting entity, because such statistics are valuable information. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide statistics to a requesting entity to foster a business relationship with the entity.

8. Claims 1-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fetto in view of Dennis and Garg (US 6,009,407).

Regarding claims 1-7 and 13-17, Fetto and Dennis disclose the steps of receiving a request for a product, determining an appropriate retailer, submitting the request to the retailer, and allowing the customer to chose to have the product shipped to her or to pick it up from the retailer.

Fetto and Dennis do not disclose the step of providing a code to the consumer. However, it is common in the art at the time the invention was made to provide customers with an order number upon completion of an order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the consumer and the retailer with a code to enable the retailer to provide the customer with the ordered product.

Fetto and Dennis do not disclose an inventory management system. Garg discloses an inventory management system as described in paragraph 6 of this Office Action. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the inventory management system of Garg with the combination of Fetto and Dennis to ensure that the specified retail location does have the product in stock.

Regarding claims 8-11, Fetto discusses a web site from which a customer may remotely order an item. The customer may then pick up the item from the nearest store or have it shipped to her home (p. 2, first paragraph).

Fetto does not disclose the steps of providing a terminal at a retail location or the steps of processing funds. However, it is common in the art to provide internet terminals at retail locations, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of providing an internet terminal at a retail location in combination with the disclosure of Fetto because such internet terminals generate additional revenue. It is also common in the art e-commerce to receive payment information, convert the payment information to an electronic debit format, and providing funds to the manufacturers. It

would have been obvious to one of ordinary skill in the art to employ such steps with the disclosure of Fetto to facilitate the remote ordering process.

Fetto does not disclose the steps of identifying a retail location that has stock of the product and that is located proximally to the user, transmitting the identified retail location to the terminal, and displaying it to the user. Dennis discusses an Internet site that transmits to users retail locations that are located proximally to the user and have stock of the product requested (p. 2, first and second paragraphs). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Dennis with the system discussed by Fetto to only transmit retail locations that actually have the product in stock.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis, Fetto, and Garg (US 6,009,407), as applied to claim 1 above, and further in view of Rogers et al. (US 5,978,774).

Dennis, Fetto, and Garg disclose all of the limitations of the claim except for the steps of returning a product. Rogers et al disclose a product transaction system having a process for returning a product comprising the steps of allowing the customer to return the product to the retailer, receiving a notification from the retailer, and updating the sales report (col. 8, line 58 through col. 9, line 31).

Response to Arguments

10. Applicant's arguments filed October 30, 2006 have been fully considered but they are not deemed persuasive.

11. Regarding the argument that the database of Garg is not remote from the manufacturers and the retailers, the database of Garg is indeed remote from the "manufacturers" and the "retailers," since the database would be used and controlled by the "managers," thus would be inherently "remote" from both the "manufacturers" and "retailers."

12. To the extent that applicant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

13. Regarding the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case the knowledge generally available to one of ordinary skill in the art would include the necessary motivations and suggestions to combine the references, as set forth in the applied rejection(s).

15. To the extent that applicant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but ***need not be in the identical words*** as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to the disclosure.

17. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at:

<http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at:

<http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

November 26, 2007

 11/26/07

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627